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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,523	01/26/2005	Guy Marck	Q85512	7429
23373	7590	12/13/2007		
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037				
			EXAMINER LISTVOYB, GREGORY	
			ART UNIT 1796	PAPER NUMBER
			MAIL DATE 12/13/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/522,523

Applicant(s)

MARCK ET AL.

Examiner

Gregory Listvoyb

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3-67 is/are pending in the application.
- 4a) Of the above claim(s) 42-67 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3,6-8,12,13,18,22,25-30 and 32-35 is/are rejected.
- 7) ☒ Claim(s) 4,5,9-11,14-17,19,20,22-24,31 and 36-41 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Examiner noticed that only claims 48-67 were withdrawn in the Amended set of Claims filed on 9/17/2007. However, in Office Action from 3/8/07 the following groups were indicated:

Group 1, claim(s) 1-41, drawn to intermediate product (diamine).

Group 2, claim(s) 42-54 and 57-58, drawn to polymer (polyamic acid and polyimide).

Group 3, claim(s) 55-56 and 59-67, drawn to a composition (crosslinked product).

Since the Applicant chose Group 1 (Claims 1-41), claims 42-67 should be withdrawn.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3, 6-8, 12, 13, 22, 25-30, 32-35 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention,

In Claims 3, 6-8, 12, 13, 22, 25-29, 33 a term "may" is inappropriate and should be replaced, because it is unclear if or to what extent the language denoted by "may" is optional.

In Claims 6, 8, 12, 22, 27, 28, 29, 33 term "lower alkyl" is indefinite and should be replaced, because it is quantitatively unclear exactly what constitutes "lower".

In Claims 3, 9, 21, 30, 34 terms "preferably", "particularly preferred", "more preferred" or "especially preferred" are indefinite and should be replaced, because it is unclear if or to what extent the preferred language further modifies less preferred language.

In Claims 9, 32, 35 term "the like" is indefinite and should be replaced, because "like" so extends the scope of the language that it cannot be determined exactly what the language encompasses.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 18 rejected under 35 U.S.C. 102(b) as being anticipated by Beilstein (1988-2001 Beilstein Institut, cited in IDS) or Takao et al (US 6139927) herein Takao as evidenced by Crabtree et al (US 4725342) herein Crabtree.

Beilstein (see previous Office action) and Takao (Column 56, Example 20) disclose a diamine of Formula 1, where A1 and A2 are Nitrile, Ester, Acid, Alkyl (Beilstein) and Alkyl (Takao).

Crabtree evidences that even chemically inert alkanes can be dimerized photochemically (see Column 1, line 20).

Therefore, all the diamines disclosed in Beilstein and diamine of Takao inherently can be photodimerized.

#### ***Allowable Subject Matter***

Claims 4-5, 9-11, 14-17, 19, 20, 22-24, 31 and 36-41 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Response to Arguments***

Regarding Applicant's arguments filed on 9/1/07 have been fully considered, but they are not persuasive.

The Applicant argues "that a diamine according to claims 1 to 41 only makes sense if finally it will be conducted into the end structure." The diamine of claimed structure can be used as a raw material for different classes of polymers ([polyamides or polyurethanes), which are not limited to polyimide

There are no other arguments on the above Remarks. Note that newly amended Claim 18 is rejected in the present action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Listvoyb whose telephone number is (571) 272-6105. The examiner can normally be reached on 10am-7pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


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Gregory Listvoyb  
Examiner  
Art Unit 1796

GL  
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RABON SERGENT  
PRIMARY EXAMINER